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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,162

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John R. Pendray

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7590

10/18/2006

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EXAMINER

RENNER, CRAIG A

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/797,162

Applicant(s)

PENDRAY ET AL.

Examiner

Craig A. Renner

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006 & 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 2-9, 12, 15-18, 20, 21, 24-28, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 13, 14, 19, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of "group 1, consisting of claims 1, 10-11, 13-14, 19, and 22-23," in the reply filed on 12 June 2006 is acknowledged. The traversal is on the ground(s) that "examining claims 1-28, 39 and 40 in a single group would be appropriate, as indicated by the previous action by the Patent Office in indicating claims 1-28 to belong to a single group and substantively examining them as such. Additionally, the applicants submit that withdrawing the restriction requirement would be proper because the characteristic subject matter given to define Group 1, of a slider with a debris shield, does not appear in any of the claims except claim 23; the characteristic subject matter given to define Group 2, of a slider with a third coefficient of expansion... greater than a second coefficient of expansion, does not appear in any of the claims except claim 21; and the characteristic subject matter given to define Group 3, of a slider with a landing pad, does not appear in any of the claims except claim 24. The subject matter of all pending claims besides those three, does not correspond to the defining characteristic subject matter given for any of the three inventive groups described, and therefore even under the rationale provided for the restriction requirement, do not belong to separate inventive groups, and should be examined together. This is true between groups 1 and 2, 1 and 3, and 2 and 3, so each aspect of the restriction is specifically traversed. Furthermore, withdrawing the restriction would be proper because the identified subcombinations overlap in scope. Group 1 includes

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independent claim 1. All other claims in group 1, and all but one claim in each of groups 2 and 3, are dependent on claim 1, and therefore share in common the subject matter of claim 1 that per se overlaps between the different claims. The remaining two claims, 39 and 40, also include subject matter that overlaps with claim 1. Restriction between subcombinations requires that 'the subcombinations do not overlap in scope' (MPEP 806.05(d)). Therefore, none of the claims would be properly be restricted as different subcombinations. This is true between groups 1 and 2, 1 and 3, and 2 and 3, so again, each aspect of the restriction specifically traversed. The applicants therefore respectfully submit that claims 1-28 and 39-40 have been demonstrated to be within a single inventive group, and have previously been shown to be allowable. The applicants accordingly respectfully request that the examiner withdraw the restriction requirement as to each of the identified inventive groups, and allow claims 1-28 and 39-40."

These arguments, however, are not found to be persuasive because applicant's substantial amendments to the claims resulted in the requirement for restriction and the search for the invention of group I is no longer coextensive with the search for the inventions of groups II and III as evidenced by their different classifications, detailed in paragraph 1 of the Office action filed 10 May 2006. Therefore, searching for the inventions of all three groups could not be done without serious burden. Additionally, it is noted that applicant misquotes MPEP § 806.05(d), which requires that "the subcombinations do not overlap in scope and are not obvious variants" (emphasis added). Applicant has not yet admitted on the record that the subcombinations are

obvious variants. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL. Accordingly, claims 2-9, 12, 15-18, 20, 21, 24-28, 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim.

### ***Drawings***

2. The drawings were received on 01 March 2006. These drawings are accepted.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Pust et al. (US 6,661,605).

Pust teaches a slider (40/80) comprising a substrate (42) having a first coefficient of expansion responsive to a stimulus; a transducer (90) disposed on the substrate, the transducer having a second coefficient of expansion responsive to the stimulus that is greater than the first coefficient of expansion (lines 6-12 in column 8, for instance); and a hydrodynamic surface comprising at least a portion of a bearing surface (ABS) and a responsive aeroelastic deposit (68) having a third coefficient of expansion responsive to the stimulus that is greater than the first coefficient of expansion (lines 6-12 in column 8, for instance).

#### ***Pertinent Art***

5. The art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes Serpe et al. (US 7,064,930), which will continuously be reviewed and considered for potential obvious-type double patenting. Currently, at least claim 1 of the present application is obvious in view of at least claim 4 of Serpe et al. (US 7,064,930). However, since applicant has not yet overcome the prior art rejection, *supra*, an obvious-type double patenting rejection will not be made at this time.

***Allowable Subject Matter***

6. Claims 10, 11, 13, 14, 19, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed 01 March 2006 have been fully considered but they are not persuasive.

The applicant argues that "Pust does not disclose a hydrodynamic surface comprising at least a portion of a bearing surface and a responsive aeroelastic deposit, which is required by claim 1." This argument, however, is not found to be persuasive as Pust does teach a hydrodynamic surface comprising at least a portion of a bearing surface (ABS) and a responsive aeroelastic deposit (68). The portion of the bearing surface (ABS) and the responsive aeroelastic deposit (68) will exhibit hydrodynamic properties to at least some extent. The deposit (68) may be considered "responsive" because it is responsive to thermal energy as shown in the drawings of Pust. The deposit (68) may also be considered "aeroelastic" because it will exhibit aeroelastic properties to at least some extent. It is noted that applicant has not provided any evidence to show that the portion of the bearing surface (ABS) and the responsive aeroelastic deposit (68) cannot exhibit hydrodynamic properties to any extent, and that the deposit (68) cannot exhibit aeroelastic properties to any extent. In the event that the applicant submits an affidavit to such affect, applicant is reminded that willful false

statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Monday-Tuesday & Thursday-Friday 9:00 AM - 7:30 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Craig A. Renner  
Primary Examiner  
Art Unit 2627

CAR